



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,102	04/21/2000	Christopher T. Davey	BSC-134	6730

7590 08/26/2003
Fay Kaplun & Marcin LLP
150 Broadway
Suite 702
New York, NY 10038

EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
----------	--------------

3763

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,102

Applicant(s)

DAVEY, CHRISTOPHER T.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23, 25-34 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23, 25-34 and 36-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-23, 25-34, 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (USPN 5755693) and further in view of Deem et al. (USPN 5104389).

Walker et al. discloses a catheter with a sheath, a proximal hub portion, an elongated body portion, a passageway extending, a pair of lines extending at least some of the length of the sheath, wherein the sheath being separable along the lines, and a valve comprising a foam material, wherein the length of the foam material within the passageway being greater than the width of the foam material at any point within the passageway, and one or more self-sealing slits in the foam, but fails to disclose wherein none of the slits extend in width to the inner surface of the sheath.

Deem et al. discloses a sheath with a hub and an elongated body, wherein a foam valve is inserted into the hub and wherein the length of the foam material within the passageway being greater than the width of the foam material at any point within the passageway, and one or more self-sealing slits in the foam material, where none of the slits extend in width to the inner surface of the sheath, and where the foam material is affixed to a portion of an inner surface of the sheath that defines the passageway. As in

Art Unit: 3763

claim 17,18, wherein the elongated body portion comprises at least a first section, and a second section, where the first cross-sectional area is larger than the second cross-sectional area and further comprises a shoulder disposed within the passageway and between the first and second sections. The reference shows a first cross-sectional area starting after the valve, and then the shoulder, and then the second cross-sectional area. As in claim 22, 34, 45 wherein the foam material comprises a closed cell foam.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine Walker et al. with Deem et al. because it is well known in the art to use a foam valve with non extending slits as well as closed cell foam as taught by Deem et al. for the purpose of helped in stabilizing and securing the trocar in relationship with the elongated body.

Therefore, it would have been obvious to combine Walker et al. with Deem et al. to obtain the invention as specified in claims 12-23, 25-34, 36-45.

Response to Arguments

3. Applicant's arguments filed 07/24/03 have been fully considered but they are not persuasive.

4. The applicant first states reasons why the 103 Rejection is not proper, such as there are no slits on the surface of the valve, and the slits on the valve extend to an inner surface of the sheath, and finally the foam material does not have a length greater than a width of the foam material. The Examiner disagrees with these arguments for the reasons as follows; for the slits not being on the surface of the valve, this is shown in

Art Unit: 3763

Walker et al. (Figure 4, Reference number 32, Fig. 7, Fig. 8, Fig. 25) and Deem et al. (Fig. 5, Ref. # 40 [Column 5, lines 57-64]). As for the slits on the valve not extending to an inner surface of the sheath, this can be seen in Walker et al. (Fig. 8, Ref # 32) and Deem et al. (Fig. 5, Ref. # 40). And finally foam material does not have a length greater than a width of the foam material, this is stated in Walker et al. (Fig. 9, Column 7 lines 37-43) and Deem et al. (Column 5, lines 6-14 as well as supported by the Figures 1 & 2).

5. The applicant next argues that no motivation is shown, this is not true, the motivation is shown in Deem et al. for using the valve as described within Deem et al. because of the specific characteristics of the closed foam, the slits of the valve that do not extend to the sheath, and the length and width of the foam material is described in Column 2 – Column 3, as well as in Column 5, lines 60-64.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. The examiner further states case law to further support his 103 Rejection; the disclosures in a reference must be evaluated for what they would fairly teach one of

Art Unit: 3763

ordinary skill in the art. In re Snow, 471 F.2d 1400, 176 USPQ 328 (CCPA 1973); In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). Specifically, in considering the teachings of a reference, it is proper to take into account not only the specific teachings of the reference, but also the inferences that one skilled in the art would reasonably have been expected to draw from the reference. In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968); In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). In addition, it is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

8. While there must be some teaching, reason, suggestion, or motivation that the references be combine to arrive at the claimed invention, there is no requirement that the references explicitly suggest the combination. In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). The suggestion or motivation to combine the references or teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. In re Wood, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3763

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1-703-308-0858.

Aut

Matthew DeSanto
Art Unit 3763
August 19, 2003

Brian L. Casler
BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700